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#21

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Stephen M. REUNING
Serial No. : 09/897,826
Filing Date : 03 July 01
Title : Candidate Chaser
Group Art : 2175
Examiner : Laufer, S.P.E.

5
RULE 1.181(a) PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Applicants respectfully requests that the office withdraw the holding of Abandonment pursuant to Rule 181(a) and Manual of Patent Examining Procedure § 711.03(c)(1)(B) (2004), and return the case to the Board of Patent Appeals and Interferences for Rehearing.

STATEMENT OF FACTS

1. The captioned application is a continuation of parent application serial no. 08/984,650. The parent was filed 3 Dec 1997.

2. On concluding the four-year prosecution of the parent application, the Examiner agreed that certain subject matter was patentable over the art of record, based on Applicant's antedating Rule 131 Affidavit.

3. Applicant accordingly filed the immediate continuation application, claiming this subject matter. These claims were, surprisingly, rejected because the Examiner did not consider the earlier-filed antedating Affidavit.

4. Applicant thus filed an Appeal. On 12 July 2004, the Board issued a Docketing Notice. That Notice advises:

The facsimile number of the Board is 703-308-7952. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended.

5 5. On 30 Sept. 2004, the Board issued its Order, affirming the rejections without considering the Affidavit.

10 6. On 23 November 2004, I filed a Rule 97(b) REQUEST FOR REHEARING (copy enclosed). This request is believed timely filed, because it was filed within two months of the mailing date of the Board's decision. Per the Board's instruction, I submitted this by facsimile to the Board at 703-308-7952. Per Rule 1.8, I accompanied this with a Certificate of Facsimile Transmission.

15 7. On 25 Jan 2005, the Examiner issued a Notice of Abandonment. That Notice does not mention my 23 November 2004 communication.

20 8. It appears, then, that my 23 November 2004 communication was not received in the Patent and Trademark Office. Rule 1.8(b) says:

25 (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned . . . , the correspondence will be considered timely if the party who forwarded such correspondence:

30 (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

35 (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

37 C.F.R. 1.8(b) (emphasis added). To obtain benefit of the Rule, then, Applicant must satisfy several legal elements:

- (a) the communication must have been transmitted in accordance with 1.8(a);
- (b) the communication was not received in the Patent and Trademark Office;
- (c) the application is held abandoned;
- (d) Applicant informs the Office of the previous correspondence promptly after becoming aware of the loss;
- (e) Applicant supplies an additional copy of the correspondence;
- (f) Applicant includes a statement which attests on a personal knowledge basis to the previous timely transmission.

9. Accordingly, On 3 Feb 2005, I submitted a duplicate copy of my 23 Nov. 2004 Rule 97(b) REQUEST FOR REHEARING, requesting that the holding of abandonment be withdrawn.

10. The 3 Feb 2005 submission includes all of the elements required of a PETITION under Rule 1.181(a). The 3 Feb 2005 submission also fulfils each of the elements of Rule 1.8(b). Specifically:

- (a) the communication was transmitted by facsimile in accordance with 1.8(a);
- (b) the communication apparently was not received in the Patent and Trademark Office;
- (c) the application was held abandoned;

5 (d) Applicant informed the Office of the previous
correspondence promptly after becoming aware of
the loss (F.Y.I., I sent the 3 Feb 05
communication the same day I became aware of the
loss);

10 (e) the 3 Feb 05 communication supplied an
additional copy of the earlier correspondence; and

15 (f) the 3 Feb 05 communication includes a
statement which attests on a personal knowledge
basis to the previous timely transmission ("On 23
Nov 04, I filed a Request for Reconsideration").

20 The 3 Feb 2005 Petition therefore fulfils each of the
elements of Rule 1.8(b).

25 11. It may be argued that without a printed receipt showing
proper reception of the facsimile by the Patent Office, there
is no corroboration for my affirmation of timely
transmission. Rule 1.8(b)(3), however, does not require
documentary evidence; to the contrary, Rule 1.8 by its own
terms applies where the communication is "not received" by
the Office at all - and thus where no receipt can be issued.
Similarly, Rule 1.8(b)(3) should not be read to require
Applicant to provide a receipt of facsimile delivery, because
this would raise a standard impossible to meet, because the
Board does not provide facsimile transmissions receipt.

30 12. The 3 Feb 2005 Petition therefore fulfils each of the
elements of Rule 1.8(b).

35 13. Today, I spoke with Supervisory Patent Examiner Pinchus
M. Lauffer, Esq., who kindly requests that I re-file my 3
Feb. 05 Petition in a more formal format. I respectfully
believe the immediate paper does this.

POINT TO BE REVIEWED

Whether the holding of Abandonment may be withdrawn pursuant to Rule 1.8(b)?


ACTION REQUESTED

Applicant respectfully requests that the holding of Abandonment be withdrawn pursuant to Rule 1.8(b), and the request for Reconsideration forwarded to the Board for review.

ENCLOSURES

I enclose copies of the 23 November 2004 Request and the 3 Feb 2005 communication. No fee is believed required for this Petition.

Respectfully submitted,
PHARMACEUTICAL PATENT ATTORNEYS, LLC


By Mark Pohl, Reg. No. 35,325
55 Madison Avenue, 4th floor
Morristown, NJ 07960-7397

28 June 2005

SD:AA Office\Forms - Patents\Petition - Rule 181(a)



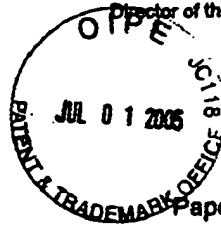
United States Patent and Trademark Office

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, D.C. 20231 www.uspto.gov



PHARMACEUTICAL PATENT ATTORNEYS, LLC
55 MADISON AVENUE
4TH FLOOR
MORRISTOWN NJ 07960-7397

Paper No.: 18
Appeal No: 2004-1714
Appellant: REUNING, STEPHEN MICHAEL
Application: 09/897,826

Board of Patent Appeals and Interferences

Docketing Notice

Application 09/897,826 was received from the Technology Center at the Board on 15-Jun-04 and has been assigned Appeal No: 2004-1714.

A review of the file indicates that the following documents have been filed by applicant:

Appeal Brief filed on: 10/24/03

Reply Brief filed on: 3/8/04

Request for Hearing filed on: None

In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

The facsimile number of the Board is 703-308-7952. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 703-308-9797 and should be directed to a Program and Resource Administrator.



Please type and sign (1) inside this box → ☐

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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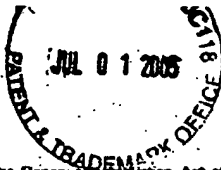
TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/897,826
	Filing Date	3 July 2001
	First Named Inventor	Stephen M. REUNING
	Group Art Unit	2175
	Examiner Name	Samuel RIMELL, Esq.
Total Number of Pages in This Submission	Attorney Docket Number	Diedre Moire Corp.

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below)
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	Enclosed find a Request for Rehearing under Rule 197(b). No fee is enclosed, because none is believed required.
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Pharmaceutical Patent Attorneys, LLC 55 Madison Avenue, 4th floor, Morristown NJ 07960-7397 USA
Signature	
Date	See below date

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: <input type="text"/>	
Typed or printed name	Mark POHL, Reg. No. 35,325
Signature	Date 23 Nov 04

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



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Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the
United States Patent and Trademark Office Central Facsimile Center
(703) 872-9306

on 23 Nov 04

Date

Signature

Mark POHL, Reg. No. 35,325

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

The submitted papers are enumerated on the enclosed Transmittal Form,
PTO Form SB/21.



IN THE UNITED STATES PATENT OFFICE

5 *Ex parte* Stephen M. REUNING
Serial No. 09/897,826
Filing Date: 03 July 2001

Appeal No.: 2004-1714

10 Rule 197(b)
REQUEST FOR REHEARING

15 Honorable Commissioner for Patents
Post Office Box 1450
Mail Stop - Board of Patent Appeals
Alexandria, VA 20231

20
RULE 197(B) REQUEST FOR REHEARING

25 This REQUEST FOR REHEARING is submitted in response to the DECISION ON APPEAL (30 Sept 2004). This paper is due within two months of the mailing date of the DECISION ON APPEAL; this paper is thus believed timely filed. No fee is believed required.

30 GROUNDS UPON WHICH REHEARING IS SOUGHT

Applicant respectfully believes the Board has failed to fully understand the agency's previous administrative fact findings. Applicant senses that this error may simply be due to the Office's failure to forward to the Board the complete prosecution history, including a copy of the parent application file, Serial No. 08/984,650.

35 The immediate case recites claims copied from the parent application. In the parent case, the Examiner accepted Applicant's RULE 132 DECLARATION to antedate the MCGOVERN reference. In the immediate case, however, the Examiner refuses to accept the same DECLARATION, to antedate the same reference, for the same claims.

POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED

The DECISION ON APPEAL correctly notes that "the claims on appeal are different from the claims allowed in the parent application." See DECISION ON APPEAL at 3.

5 This is incorrect. The claims on appeal are different from those recited included in the published issued parent patent. The parent application, however, included additional claims found allowable by the Office. After the Office confirmed the patentability of this subject matter, these claims were deleted from the parent and filed in the immediate case, based on the Examiner's representation that these claims would be promptly allowed.

10 The DECISION ON APPEAL also misapprehends the content of MCGOVERN, because the DECISION contradicts the agency's administrative factual findings that MCGOVERN fails to each claim element.

The DECISION accurately summarizes the claimed invention as a system for locating an individual with specifically defined professional qualifications. See DECISION at 1. The
15 DECISION accurately summarizes the claimed invention:

- 20 1. A system for locating an individual with specifically defined professional qualifications, the system comprising: a. a filter that can search a web page to identify in said web page the presence or absence of specifically defined professional qualifications, and b. an e-mail address extractor that can extract an e-mail address from said web page.

Thus, application claim 1 entails using specifically defined criteria to filter web pages, and then extracting email addresses from them. The parent application recited similar application claims.

For example, parent application claim 18 claims:

- 25 18. A computer implemented method comprising: a. locating an Internet site page or web posting which contains operator specified text comprising specifically defined experiences ...; b. extracting from said Internet site page or web posting an email address; and c. sending an electronic mail message to said extracted address.
- 30

See AMENDMENT IN SERIAL NO. 08/984,650 at 4-5 (15 Feb. 2000). Thus, parent application claim 18, like the immediate application claim 1, entails using specifically defined criteria to filter web pages, and then extracting email addresses from them.¹

5 In the parent case, parent application claim 18 was rejected as obvious over MCGOVERN. See OFFICE ACTION at 4-6 (1 May 2000).

In response, Applicant submitted a RULE 132 DECLARATION (14 July 2000). In response, the Office withdrew the obviousness rejection over MCGOVERN and conceded that claim 18 is patentable. See e.g., OFFICE ACTION at 2 (24 Aug. 2000).

10 In response to the 1 May 2000 obviousness rejection over MCGOVERN, Applicant also explained that "McGovern does not disclose a system involving getting an e-mail address – by extraction or otherwise – from an Internet page or web posting; McGovern's e-mail addresses need to be individually sent to or input into the system." See AMENDMENT at 6-7 (14 July 2000) (emphasis in original). In response, the Office withdrew the rejection based on MCGOVERN and conceded that claim 18 is patentable. See e.g., OFFICE ACTION at 2 (24 Aug. 2000).

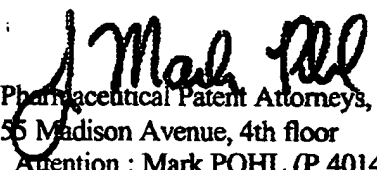
15 The Office made an express written finding that claim 18 is patentable (in fact, the Office reiterated this finding more than once). The Office has found that "comparing text against professional qualifications and electronically extracting e-mail addresses when those qualifications are met" is a novel, non-obvious combination. Based on the Office's written fact finding, Applicant filed the immediate application. Having made this fact finding, and having
20 represented to Applicant *in writing* that the immediate subject matter is patentable, the Board should not condone the Examiner's arbitrary and capricious change in position.

¹ N.B.: Parent application claim No.18 also includes a third step: sending an email. It might have been argued that this third step differentiates the two claims, making the Applicant's Declaration applicable to one, but not the other. The Office, however, specifically rejected this argument, finding, to the contrary, that extracting an email address inherently includes sending an email as a mere obvious variant thereof. The Office has therefore found step c. not material.

SUMMARY

The DECISION ON APPEAL (30 Sept 2004) relies on factual assumptions which are directly contradicted by the agency's prior administrative fact findings. MCGOVERN fails to include each claim element, and MCGOVERN must be withdrawn as a reference because the Office has previously concluded that Applicant antedates it.

Respectfully submitted,


Pharmaceutical Patent Attorneys, LLC
55 Madison Avenue, 4th floor
Attention : Mark POHL (P 4014)
Morristown, NJ 07960-7397 U.S.A.
23 November 2004

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Direct Mark.Pohl@LicensingLaw.Net
☎ +1 (973) 984-0076

mbc:mp

SD:\Diedre\09897,826\Appeal Reconsideration.doc



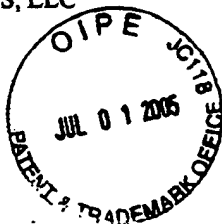
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,826	07/03/2001	Stephen Michael Reuning	Diedre/Candidate	3851

22925 7590 01/25/2005

PHARMACEUTICAL PATENT ATTORNEYS, LLC
55 MADISON AVENUE
4TH FLOOR
MORRISTOWN, NJ 07960-7397



EXAMINER

RIMELL, SAMUEL G

ART UNIT PAPER NUMBER

2165

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Notice of Abandonment

Application No.

09/897,826

Applicant(s)

REUNING, STEPHEN
MICHAEL

Examiner

Sam Rimell

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☒ The decision by the Board of Patent Appeals and Interference rendered on 9/30/04 and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

Sam Rimell
Primary Examiner
Art Unit: 2165

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Please type a plus sign (+) inside this box → ☐



PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h1>TRANSMITTAL FORM</h1> <p>(to be used for all correspondence after initial filing)</p>	Application Number	09/897,826
	Filing Date	3 July 2001
	First Named Inventor	REUNING
	Group Art Unit	Board of Appeals
	Examiner Name	RIMMEL
Total Number of Pages in This Submission	Attorney Docket Number	Diedre

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <p>Request for Rehearing</p>
Remarks: On 23 Nov 04, I filed a Request for Reconsideration with the Board (copy enclosed). I just received a Notice of Abandonment (copy enclosed). Could you please withdraw the Notice of Abandonment and provide a response to the Request for Reconsideration. MANY thanks,		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Pharmaceutical Patent Attorneys, LLC 55 Madison Avenue, 4th floor, Morristown NJ 07960-7397 USA
Signature	
Date	See below date

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date:	
Typed or printed name	Mark POHL, Reg. No. 35,325
Signature	Date 3 Feb 05

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

**Certificate of Transmission under 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the
United States Patent and Trademark Office Central Facsimile Center
(703) 872-9306

on 3 Feb 05

Date

Signature

Mark POHL, Reg. No. 35,325

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

The submitted papers are enumerated on the enclosed Transmittal Form,
PTO Form SB/21.

Fax Information
Date Received: 2/3/2005 6:00:52 PM [Eastern Standard Time]
Total Pages: 10 (including cover page)

Received
Cover
Page[illegible]